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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,584

06/21/2006

Shinji Shimada

128063

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7590

11/18/2009

OLIFF & BERRIDGE, PLC

P.O. BOX 320850

ALEXANDRIA, VA 22320-4850

EXAMINER

HICKS, ROBERT J

ART UNIT

PAPER NUMBER

3781

MAIL DATE

DELIVERY MODE

11/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/580,584	<b>Applicant(s)</b> SHIMADA, SHINJI	
	<b>Examiner</b> ROBERT J. HICKS	<b>Art Unit</b> 3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 11-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/10/2009</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Because of the applicant's amendment, the original double patenting rejection of claim 1, filed in the office action dated June 2, 2009, is hereby withdrawn.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on September 10, 2009 was filed after the mailing date of the non-final rejection on June 2, 2009. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Objections***

3. Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 11 states the label is a tack label, and is dependent from claim 3. Claim 3 states that the label is one of a heat-shrinkable label and a stretch label. There is no option available in claim 3 that would allow the label to be a tack label, since claim 3 restricts the label to one of two kinds of labels.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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**5. Claims 1, 3, 4, and 11-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

6. Regarding claim 1, the phrases "body of a type of material" [Claim 1 Line 2], and "label of the same type of material" [Claim 1 Line 4] render the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by " of a type [the same type] of material "), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). The material used for the bottle and label could be polypropylene (PP), polyethylene (PE), PET, HDPE, LDPE, PVC, EVOH, or another resin. All of the materials mentioned are in the same category of plastics, with all of the materials having different material and thermal properties. Claims 3, 4, and 11-17 are rejected as being dependent upon rejected base 1.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

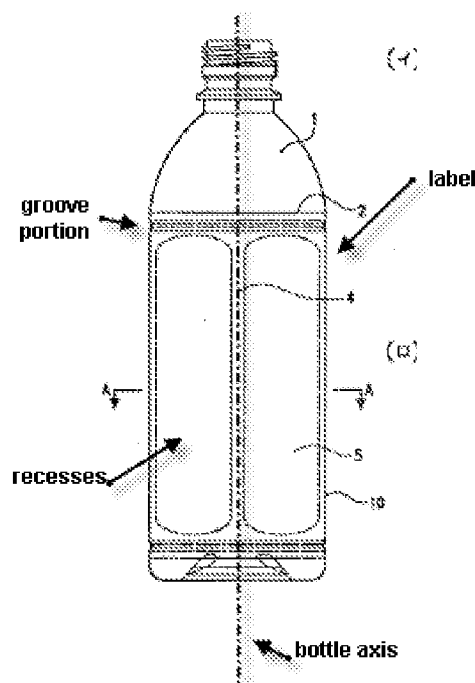
1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**9. Claims 1, 3, 4, and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takuji (JP 2003-335343) in view of Itaba et al. (5,227,233) [Itaba].**

Regarding Amended Claim 1, the publication to Takuji – a cylindrical label and container – discloses a synthetic resin container [1, Paragraph 16 Lines 6-8] comprising a container body of a material, said container body having a main portion formed with a plurality of sectioned recesses [5, Abstract Lines 8-13], said container further comprising: a label [2], arranged at said main body portion of the container body and surrounding the main body portion [Fig. 1], that provides an improved rigidity of the container, wherein the label is immovably arranged on the main body portion through an adhesive layer [Paragraph 22 Lines 15-22].



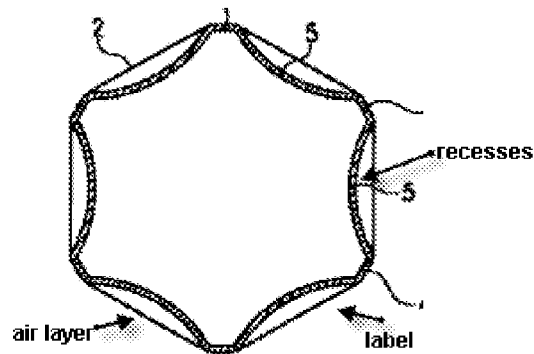
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Takuji does not expressly disclose that the label and bottle are made of the same material; however, the patent to Itaba – a polyethylene container and label – discloses that said label [**Itaba**, 2] comprises the same material as said container [**Itaba**, 1, Col. 3 Lines 41-46], and in which the label is rigid [**Itaba**, Col. 3 Lines 32-36], and immovable on the container by an adhesive [**Itaba**, Col. 5 Lines 7-15, and Col. 6 Lines 32-34]. The label and bottle are both made of polyethylene, and the label can be placed in the mold when making the container. It would have been obvious at the time of the invention to one of ordinary skill, with market forces driving one of ordinary skill to change the prior art, to modify the label in the Takuji container to be the same material as the container, as suggested by Itaba, to reduce manufacturing material costs, and so that the label can bond to the container through the manufacturing process [**Itaba**, Col. 3 Lines 37-41].

Regarding Amended Claim 3, Takuji in view of Itaba discloses all the limitations substantially as claimed, as applied to amended claim 1 above; further, Takuji discloses said label is a heat-shrinkable label, which is tightly in close contact with the container body [**Takuji**, Paragraphs 24 and 30].

Regarding Amended Claim 4 and Claim 11, Takuji in view of Itaba discloses all the limitations substantially as claimed, as applied to amended claims 1 and 3 above, respectively; further, Itaba discloses said label is a tack label [**Itaba**, Col. 6 Lines 32-34]. The label can be tacked onto the mold and the container, when the container is being molded.

Regarding Claim 12, Takuji in view of Itaba discloses all the limitations substantially as claimed, as applied to amended claim 1 above; further, Takuji discloses closed air layers provided between the plurality of sectioned recesses [Takuji, formed by panels 5] and the label [Takuji, 2, Fig. 2].



Regarding Claim 13, Takuji in view of Itaba discloses all the limitations substantially as claimed, as applied to claim 12 above; further, Takuji discloses the closed air layers form a cushion structure that absorbs impacts from outside for the container [Takuji, Fig. 5, Paragraph 22 Lines 4-7].

Regarding Claims 14 and 15, Takuji in view of Itaba discloses all the limitations substantially as claimed, as applied to amended claim 1 above; further, Takuji discloses the container has a longitudinal axis, with annular groove portions extending about the longitudinal axis, and the label is adhered at upper and lower end regions of the label along the longitudinal axis and covers the groove portions [Takuji, Fig. 1].

Regarding Claim 16, Takuji in view of Itaba discloses all the limitations substantially as claimed, as applied to claim 15 above; further, Takuji discloses the label is a heat-shrinkable label [Takuji, 2] with a heat-sensitive adhesive agent [Takuji, 3, Paragraphs 24 and 30].

Regarding Claim 17, Takuji in view of Itaba discloses all the limitations substantially as claimed, as applied to amended claim 1 above; further, Takuji discloses the material is PET [**Takuji**, Paragraph 16 Lines 6-8], and Itaba discloses the label and container can be the same material [**Itaba**, Col. 3 Lines 41-46].

### ***Response to Arguments***

10. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

11. In response to applicant's argument that the Ota et al. (2002/0000421) [Ota] reference fails to show certain features of applicant's invention regarding amended claim 1 {Remarks, Page 6 Lines 8-19}, see Paragraph 9 of this office action to see how Takuji in view of Itaba meets the claim limitations regarding amended claim 1.

12. In response to applicant's argument that the Itaba reference fails to show certain features of applicant's invention regarding the label and rigidity {Remarks, Page 6 Lines 20-25}, Itaba does disclose that the label provides rigidity for the container [Itaba, Col. 3 Lines 32-33].

13. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning {Remarks, Page 6 Lines 22-25}, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170



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USPQ 209 (CCPA 1971). In this case, Ota, Takuji, and Itaba are all plastic containers with recesses or recessed panels with labels on the exterior of the bottle to provide rigidity to the container for handling.

### ***Conclusion***

14. Applicant's amendment, and submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on September 10, 2009, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT J. HICKS whose telephone number is (571)270-1893. The examiner can normally be reached on Monday-Friday, 8:30 AM - 5:00 PM, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert J Hicks/  
Examiner, Art Unit 3781

/Anthony Stashick/  
Supervisory Patent Examiner, Art  
Unit 3781